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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN T. BRITT

Appeal 2010-006441
Application 10/729,269
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, Administrative Patent Judges.

LORIN, Administrative Patent Judge.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

John T. Britt (Appellant) seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-18. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.²

THE INVENTION

The invention relates to automating the collection, integration, analysis, reporting and archiving of data. Specification 2:6-7.

Claim 8, reproduced below, is illustrative of the subject matter on appeal.

8. A method for managing collection of samples and the collecting, preserving, integrating, processing and communication of information at locations remote from a commercial power source and from a variety of sources, comprising:

establishing requirements for said managing;

selecting a mix of hardware and software to meet said requirements;

procuring said hardware and software; and

integrating said hardware and software to implement said method.

² Our decision will make reference to the Appellant's Appeal Brief ("Br.," filed May 27, 2009) and the Examiner's Answer ("Answer," mailed Sep. 16, 2009).

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Alexander	US 6,574,561 B2	Jan. 3, 2003
Curkendall	US 6,346,885 B1	Feb. 12, 2002

The following rejection is before us for review:

1. Claims 1-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Alexander and Curkendall

ISSUES

Did the Examiner err in rejecting the claims as unpatentable over Alexander and Curkendall?

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer. Additional findings of fact may appear in the Analysis below.

ANALYSIS

The Appellant argued claims 1-18 as a group (Br. 9-35). There are two independent claims: "configuration" claim 1 and "method" claim 8. We select claim 8 (see *supra*) as the representative claim for this group, and the remaining claims 1-7 and 9-18 stand or fall with claim 8. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner addressed every claim limitation with citations to corresponding disclosures in the cited references. The Examiner's characterization of the scope and content of the cited references appear to be

accurate and have not been challenged by the Appellant. (The Appellant's argument is directed to the reasoning for combining the references to reach the claimed invention.) The Examiner takes the position that, like claim 1 (Answer 5), Alexander discloses all the claim limitations in claim 8 but for "includ[ing] a device to provide coded labels to facilitate tracking of samples, for which Curkendall is relied upon" (Answer 4). Accordingly, the Examiner established the difference between the claimed subject matter and Alexander. However, it should be noted that while this is a limitation in claim 1, it is not a limitation in claim 8 (as reproduced in the Appendix A of the Brief). Accordingly, we take the Examiner's position as to claim 8 to be that Alexander discloses all its claim limitations. The Examiner found, based on the claim 1 subject matter, that

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Alexander to include a device to provide coded labels for samples, as taught by Curkendall, to enable efficient, accurate gathering, cataloging, and communication of field data (see Curkendall, col. 1, line 14-21, Alexander, abstract).

Answer 4-5. Thus the Examiner articulated an apparent reasoning with logical underpinning in support of the legal conclusion of obviousness. All the factual inquiries for determining obviousness having been addressed and an apparent reasoning for combining the references to reach the claimed subject matter having been provided, we are satisfied that the Examiner has met the initial burden of presenting a prima facie case of obviousness.

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness

or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). In that regard, the Appellant challenges the Examiner’s reasoning for combining the references to reach the claimed subject matter. The Appellant appears to be arguing that one of ordinary skill in the art with Alexander and Curkendall in hand would not have been led to the claimed invention.

The difficulty with the Appellant’s argument is that it is not commensurate in scope with what is claimed. Throughout the Brief, the Appellant repeatedly challenges the Examiner’s rationale for combining the references on the basis of limitations not present in the claims. This is especially the case when looking at claim 8. For example, the Appellant’s key argument is that the claims provide a “unique configuration for automating the management of sample taking from various instrumentation using a system[] that is man-packable in the field.” Br. 25. The problem said to be solved by the claimed invention is that it automates what was previously done by hand. But claim 8 is not directed to a configuration. While claim 1 is directed to a configuration, there is no mention of it being “man-packable in the field.” Even if one of ordinary skill in the art would construe the claim element “portable device” to be “man-packable in the field,” claim 1 does not limit the scope of the “configuration” to the portable device. As claimed, the configuration “comprises” the portable device. Another example; the Appellant argues that “none of the references (Alexander et al., Curkendall) make a reference of the need to automate the process of collecting samples thereby eliminating or reducing error-prone manual entry and manual data manipulation.” Br. 21. However, claim 8, for

example, makes no mention of automating the process of collecting samples. A mix of hardware and software is integrated in the method of managing collection of samples and collecting of information but the scope of the claim is not limited so as to limit the collecting so as to perform it via automation. As for claim 1, it describes a configuration comprising a portable device which “may be used for said collecting.” Claim 1 also does not limit the collecting so as to perform it via automation; the collecting may be accomplished by hand with the configuration performing other tasks. We find that “[m]any of appellant’s arguments fail from the outset because, . . . they are not based on limitations appearing in the claims” In re Self, 671 F.2d 1344, 1348 (CCPA 1982).

Finally, notwithstanding that the Appellant’s argument is not commensurate in scope with what is claimed, it is generally obvious to automate a known manual procedure. Our reviewing court stated in *Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) that one of ordinary skill in the art would have found it obvious to combine an old electromechanical device with electronic circuitry

to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost. . . . The combination is thus the adaptation of an old idea or invention . . . using newer technology that is commonly available and understood in the art.

Id at 1162. Moreover, as to claim 8, the electronic configuration is simple “a mix of hardware and software to meet [established requirements for “managing collection of samples and the collecting, preserving, integrating, processing and communication of information at locations remote from a commercial power source and from a variety of sources”].”

Appellant argues that his rejected claims rest upon an automatic mechanism. The mere statement that a device is to be operated automatically instead of by hand, without a claim specifying any particular automatic mechanism, is not the statement of an invention. *Marchand v. Emken*, 132 U. S. 195, 1291 . . . ; *In re Gill*, 17 C.C.P.A. (Patents) 700, 36 F. (2d) 128. *In re Rundell*, 48 F.2d 958, 959 (CCPA 1931).

DECISION

The decision of the Examiner to reject claims 1-18 is affirmed.

AFFIRMED

mev

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